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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

09/375,867 08/17/99 LANIER

C ASTRP.235RC2

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EXAMINER

PENDER JR, M

ART UNIT

PAPER NUMBER

2762

DATE MAILED:

05/17/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/375,867**

Applicant(s)  
**Lanier et al.**

Examiner  
**Michael Pender**

Group Art Unit  
**2762**



☒ Responsive to communication(s) filed on Aug 17, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-59 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 26-35 and 45-59 is/are allowed.

☒ Claim(s) 1-25 and 36-44 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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***Detailed Action***

1. Claims 1-59 have been examined.

***Oath/Declaration***

2. This application presents a claim for subject matter not originally claimed or embraced in the statement of the invention. The amendment dated August 17, 1999 is not accompanied by a supplemental oath or declaration. A supplemental oath or declaration is required under 37 CFR § 1.67 and 35 USC § 251. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

***Claim Rejections - 35 USC § 101***

3. ***35 U.S.C. 101 reads as follows:***

*Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.*

***Double Patenting***

4. **Claims 1-25 and 36-44** of this application conflict with claims 1-25 and 36-44 of copending application 08/724,947. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention

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during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

#### ***Examiner's Comment***

6. The Examiner grants full faith and credit to the search and action of the prior examiner regarding the previous examiner's allowance of claims 26-35 and 45-59. However, Applicants must file a supplemental declaration to perfect their reduction to practice date in advance of the Nonaka patent cited as prior art in the parent application, U.S. Pat. Appl'n No. 08/724,947.

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***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to **Michael Pender** whose telephone number is **(703) 308-0147**. The Examiner can normally be reached on Monday - Friday from 8:30 A.M. to 4:30 P.M.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, **Tariq Hafiz** can be reached at **(703) 305-9643**. Any response to this office action should be **mailed to:**

**Commissioner of Patents and Trademarks Washington, D.C. 20231**

or **faxed to:**

**(703) 308-9051**, (for formal communications intended for entry), or:

**(703) 308-1396**, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

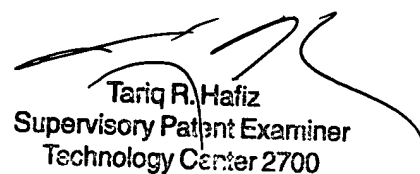
**Hand-delivered** responses should be brought to:

**Crystal Park II, 2121 Crystal Drive Arlington, Virginia, (Receptionist).**



Michael Pender

May 5, 2000



Tariq R. Hafiz  
Supervisory Patent Examiner  
Technology Center 2700